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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,578	11/17/2005	Michael Stirm	P-US-PR 1084B	3808

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EXAMINER	
SMITH, SCOTT A	
ART UNIT	PAPER NUMBER
3721	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/526,578	STIRM ET AL.	
	Examiner	Art Unit	
	Scott A. Smith	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7,9,10,12-19,21,22 and 59-64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,7,9,10,12-19,21,22 and 59-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 March 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the species of Figs. 14-15 in the reply filed on 11/7/07 is acknowledged.

2. Applicant's election with traverse of the restriction between the species of Fig. 13, and the species of Figs. 14-15 in the reply filed on 11/7/07 is acknowledged. The traversal is on the ground(s) that a combination/subcombination examinable together exists. Applicant's argument is found to be persuasive. Accordingly, claims 22 and 59-64 are hereinafter examined on the merits. Claims non-elected without traverse have been canceled.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Wanner '406.

5. Wanner '406 discloses a switching assembly for switching an overload clutch assembly of a power tool between a first mode thereof and at least one second mode, the assembly comprising: an actuator switch movable between a first position corresponding to a first mode, and at least one second position, corresponding to a respective second mode of the clutch assembly; at least one connector member for

actuating at least one actuator device of the clutch assembly in response to actuation of said actuator member; and a latching device 22 for releasably retaining said actuator member in at least one said second position.

6. Claims 1-4, 6, 7, 9, 10, 12, 21, 22 and 59-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain Application '067.

7. Great Britain Application '067 discloses an overload clutch assembly for a power tool having a spindle for rotatingly driving a working member of the tool and a spindle 1 rotary drive train for rotatingly driving the spindle, the assembly comprising: an overload clutch having a first mode in which rotary drive is transmitted to the spindle when a torque below a first predetermined level is applied to the clutch, and transmission of rotary drive to the spindle is cut when a torque above said first predetermined level is applied to the clutch, and at least one second mode in which rotary drive is transmitted to the spindle when a torque below a respective second predetermined level, lower than said first predetermined torque, is applied to the clutch, and transmission of rotary drive to the spindle is cut when a torque above said second predetermined level is applied to the clutch; and at least one actuator device for switching said overload clutch between said first mode and at least one said second mode, wherein the overload clutch comprises at least one driving gear adapted to be driven by a rotary drive train of the tool, at least one first driven gear for transmitting rotary drive to the spindle, a first coupling device for coupling at least one said driving gear and at least one said first driven gear in said first mode when a torque below said first predetermined level is applied to the clutch and enabling decoupling of said driving gear and first driven gear

when a torque above tile first predetermined level is applied to the clutch, at least one respective second driven gear for transmitting rotary drive to the spindle, and at least one respective second coupling device for coupling at least one said driving gear and at least one said second driven gear when a torque below the corresponding said second predetermined level is applied to the clutch in at least one said second mode, and enabling decoupling of said driving gear and second driven gear when a torque above the second predetermined level is applied to the clutch, a plurality of ball bearing locking elements, and a biasing means 13.

8. Claims 1-4, 6, 7, 9, 10, 12-14, 21, 22 and 59-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Takagi et al. '023.

9. Takagi et al. '023 also discloses an overload clutch assembly for a power tool having a spindle for rotatingly driving a working member of the tool and a spindle 1 rotary drive train for rotatingly driving the spindle, the assembly comprising: an overload clutch having a first mode in which rotary drive is transmitted to the spindle when a torque below a first predetermined level is applied to the clutch, and transmission of rotary drive to the spindle is cut when a torque above said first predetermined level is applied to the clutch, and at least one second mode in which rotary drive is transmitted to the spindle when a torque below a respective second predetermined level, lower than said first predetermined torque, is applied to the clutch, and transmission of rotary drive to the spindle is cut when a torque above said second predetermined level is applied to the clutch; and at least one actuator device for switching said overload clutch between said first mode and at least one said second mode, wherein the overload clutch

comprises at least one driving gear adapted to be driven by a rotary drive train of the tool, at least one first driven gear for transmitting rotary drive to the spindle, a first coupling device for coupling at least one said driving gear and at least one said first driven gear in said first mode when a torque below said first predetermined level is applied to the clutch and enabling decoupling of said driving gear and first driven gear when a torque above tile first predetermined level is applied to the clutch, at least one respective second driven gear for transmitting rotary drive to the spindle, and at least one respective second coupling device for coupling at least one said driving gear and at least one said second driven gear when a torque below the corresponding said second predetermined level is applied to the clutch in at least one said second mode, and enabling decoupling of said driving gear and second driven gear when a torque above the second predetermined level is applied to the clutch, a plurality of ball bearing locking elements 20, and a biasing means 22.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wanner '406.

13. Wanner '406 lacks the specific lever biasing means, cable connector and latching device abutting a resilient member. It would have been obvious to one skilled in the art to provide the device of Wanner '406 with the claimed specific lever biasing means, cable connector and latching device abutting a resilient member since such design expedients are deemed to be functional equivalents, and such a substitution would have been within the engineering purview of the skilled artisan.

14. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain Application '067.

15. Great Britain Application '067 lacks the specific lever biasing means, cable connector, electromagnet and latching device abutting a resilient member. It would have been obvious to one skilled in the art to provide the device of Great Britain Application '067 with the claimed specific lever biasing means, cable connector and latching device abutting a resilient member since such design expedients are deemed to be functional equivalents, and such a substitution would have been within the engineering purview of the skilled artisan.

16. Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al. '023.

17. Takagi et al. '023 lacks the specific lever biasing means, cable connector, electromagnet and latching device abutting a resilient member. It would have been obvious to one skilled in the art to provide the device of Takagi et al. '023 with the claimed specific lever biasing means, cable connector and latching device abutting a resilient member since such design expedients are deemed to be functional equivalents, and such a substitution would have been within the engineering purview of the skilled artisan.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the attached PTO-892 for related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Smith whose telephone number is 571-272-4469. The examiner can normally be reached on 5:30-4:00 Tues.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Smith

/Scott A. Smith/
Primary Examiner, Art Unit 3721